



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,987	12/21/1999	MARK L. SKARPNESS	10559/094001	5632

20985 7590 03/13/2003  
FISH & RICHARDSON, PC  
4350 LA JOLLA VILLAGE DRIVE  
SUITE 500  
SAN DIEGO, CA 92122

EXAMINER

NGUYEN, PHUONGCHAU BA

ART UNIT PAPER NUMBER

2665

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/469,987

Applicant(s)

SKARPNESS, MARK L.

Examiner

Phuongchau Ba Nguyen

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 1999.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*Specification*

1. The disclosure is objected to because of the following informalities: page 6, line 17, "decinoression" should be changed to ---decompression---.

Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6, 9, 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 ✓ recites the limitation "said second communication device" in lines 1-2. Claim 9 ✓ recites the limitation "said second port" in line 4. Claim 18 recites "said first voice interface device" in line 5. ✓ There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections – 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3-4, 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Kerpez (6,430,199).

Regarding claims 1, 3:

Kerpez discloses a modular communication system (fig.1), comprising: a first communication device 100, having

a first port 34 which allows receiving broadband information,

an expansion port 94 which provides output data to allow adding additional data-receiving elements thereto, and

a first electronic element (10, 11) which analyzes said broadband information and separates first information (data)(claim 3) intended for said first communication device from second information (voice)(claim 3) that is not intended for said first communication device, and couples said second information to said expansion port.

**Regarding claim 4:**

Kerpez further discloses wherein said first electronic element (10-11, i.e., 11) produces an output in Ethernet format (61 in fig.1) {col.4, lines 8-11, 13-51}.

**Regarding claim 8:**

Kerpez (6,430,199) discloses a voice and data device 100 (fig.1), comprising:

a connection 34 to a high bandwidth information stream 2;

a controller (10, 11) which investigates information from said high bandwidth stream, and determines portions of said information which represent data 60 and other portions of said information which represent voice 50;

Art Unit: 2665

a first output port 96 for said data; and  
an expansion output port 94 for said voice.

**Regarding claim 9:**

Kerpez further comprises a universal serial bus host 34, coupled to receive said other portions of said information 50 (fig.1), and produce an output indicative thereof, at said second port (expansion output port).

**Regarding claim 10:**

Kerpez further discloses wherein said controller (10-11, i.e., 10) formats said data into a standard network format {fig.1, col.4, lines 8-11, 13-51}.

**Regarding claim 11:**

Kerpez further discloses wherein said standard network format is a format from the group consisting Ethernet, USB or HPNA {col.4, lines 39-51, i.e., 10BaseT signal (Ethernet signal)}.

Art Unit: 2665

6. Claims 16–19 are rejected under 35 U.S.C. 102(e) as being anticipated by Frankel (6,075,784).

**Regarding claim 16:**

Frankel discloses a method of providing service to a user, comprising:  
providing the user 7 with a first device (10) which provides a first level of service for data (via 170, fig.2), said first device including an expansion capability; and

expanding the service to the user 7 by allowing the expansion capability to be used for an additional service (via 160 & 150), said additional service including at least voice (analog telephone signals).

**Regarding claim 17:**

Frankel further discloses wherein said expanding comprises providing the user 7 with an additionally expandable voice module (14, fig.1), which allows a plurality of voice lines (terminals 10, fig.1) to be obtained.

**Regarding claim 18:**

Frankel further comprises allowing further expansion by allowing additional voice lines (lines 25, fig.1) to be obtained by providing the user 7 with a second voice interface device (160, fig.2) which connects to said first voice interface device (150, fig.2).

**Regarding claim 19:**

Frankel further discloses wherein said expanding comprises determining information intended for said module 14 (to voice terminals 10, fig.2 via 110), and sending all information (data) not intended for said module (voice terminals 10) to said expansion capability (Ethernet 170, fig.2).

***Claim Rejections – 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary



Art Unit: 2665

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 5, 12–14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerpez in view Edson (6,526,581).

Regarding claims 2, 5:

Kerpez does not explicitly disclose the claimed features. However, in the same field of endeavor, Edson discloses a second communication device/universal serial bus adapter 312 (claims 5/2) for receiving said voice information. Therefore, it would have been obvious to an artisan to apply Edson's teaching of voice adapter 312 to coupled to said expansion output port 94 in Kerpez's system and the motivation being to emulate an analog type plain old telephone service (POTS) type line appearance to the telephone 32; to send and receive tone signals and analog speech communications; also to provide the necessary conversions between digital and analog and sends and receives data messages over the media 21 relating to the standard telephone line signaling used by the POTS telephone 32; and to provide a normal analog interface between the line 21 and the telephone device 32 and the logic to select between analog and digital communications {col.8, lines 12–31, Edson}.

Art Unit: 2665

**Regarding claims 12-14:**

Kerpez does not explicitly disclose the claimed features. However, in the same field of endeavor, Edson (6,526,581) further comprises a voice adapter 312 (figs.1& 3) to receive voice information (claim 12), wherein said voice adapter 312 includes a pulse code modulation adapter device (CODEC 57, col.14, lines 3-17) (claim 13), wherein said voice adapter has connectors (51&53, col.13, line 30) for at least one telephone 32 (claim 14). Therefore, it would have been obvious to an artisan to apply Edson's teaching of voice adapter 312 to coupled to said expansion output port 94 in Kerpez's system and the motivation being to emulate an analog type plain old telephone service (POTS) type line appearance to the telephone 32; to send and receive tone signals and analog speech communications; also to provide the necessary conversions between digital and analog and sends and receives data messages over the media 21 relating to the standard telephone line signaling used by the POTS telephone 32; and to provide a normal analog interface between the line 21 and the telephone device 32 and the logic to select between analog and digital communications {col.8, lines 12-31, Edson}.

9. Claims 6-7, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerpez and Edson as applied to claims 1, 8, 12 above, and further in view of Frankel.

**Regarding claims 6, 7:**

Kerpez does not explicitly disclose the claimed features. However, in the same field of endeavor, Frankel discloses a system 7, wherein said second communication device 100 includes a memory device (130, 140, fig.2), programmed with a plurality of identifying numbers (i.e., telephone numbers of terminals 10), and an information separator (110), which separates said voice information into a first part represented by said identifying numbers, and a second part (i.e., Ethernet address) that is not represented by said identifying numbers (claim 6); also, Frankel further comprises an expansion port (connection to Ethernet 170) on said second communication device 100, receiving said second part (Ethernet data, which is not analog telephone signals) (claim 7). Therefore, it would have been obvious to an artisan to apply Frankel's teaching into Kerpez's system and the motivation being to provide call set-up control and voice-band data conversion; to update or to modify by

Art Unit: 2665

employing a reprogrammable non-volatile ROM, such as a "flash" memory; to generate a control message (formatted into a call control packet) indicating the off-hook status and requesting a dial-tone, that is transmitted to the HDT 200 via the LPN 60; to determine whether there is available bandwidth on the DSL 24 based on the number of other voice calls currently being maintained by the RDT 100. If there is available bandwidth, then the message is sent to the HDT 200; otherwise, a "busy" or other signal indicating unavailability is sent to that telephone device; and to assign priority of use of the local loop link to voice traffic over data traffic by designating a portion of an available bandwidth for voice traffic, for all or adjustable time periods during a day.

**Regarding claim 15:**

Kerpez and Edson do not explicitly disclose the claimed features.

However, in the same field of endeavor, Frankel (6,075,784) discloses a device 100 comprising a memory device (130, 140, fig.2) that stores numbers indicating information intended for said voice adapter. Therefore, it would have been obvious to an artisan to apply Frankel's teaching into Kerpez's

system and the motivation being to store a software program on controller 110 so that to operate the controller 110 for updated or modified by employing a reprogrammable non-volatile ROM, such as a "flash" memory and to performs two major functions: call set-up control and voice-band data conversion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuongchau Ba Nguyen whose telephone number is 703-305-0093. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 703-308-6602. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Application/Control Number: 09/469,987  
Art Unit: 2665

Page 13

PN

Phuongchau Ba Nguyen  
Examiner  
Art Unit 2665

February 27, 2003

  
2/28/03